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Hewlett Packard Enterprise
3404 E. Harmony Road
Mail Stop 79
Fort Collins, CO 80528

EXAMINER

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chris.mania@hpe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TROY SHAHOUMIAN and HARLAN CROWDER

Appeal 2014-008057
Application 10/157,661¹
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Troy Shahoumian et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 2, 5–12, 15, 16, and 20–23. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND OF REJECTION.

¹ The Appellants identify Hewlett-Packard Development Company, LP as the real party in interest. App. Br. 1.

THE INVENTION

Claim 6, reproduced below, is illustrative of the subject matter on appeal.

6. A method for customizing the content of targeted advertising, comprising:

creating a record of in-store behavior having at least one item of expressed interest as expressed by a user, wherein said creating of said record comprises recording an in-store purchase of said item of expressed interest;

creating a targeted message comprising advertisement information about said item of expressed interest and additional advertisement information about another item for which the user has not expressed an interest, wherein said creating of said targeted message comprises creating a customized Web page having said additional advertisement information about said another item; and

sending said targeted message to the user.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Bouve	US 2002/0169541 A1	Nov. 14, 2002
Crawford, Jr.	US 8,392,245 B1	Mar. 5, 2013

Belk Launches E-Commerce Website Featuring New Online Gift Registry For Bridal Customers, PR NEWSWIRE, January 18, 2001 at 1 [hereinafter Belk].

William M. Bulkeley, *Technology (A Special Report) --- What's Ahead for... Retailing: Retail stores are bringing the Net into the world of bricks and mortar*, THE WALL STREET JOURNAL (N.Y.), June 25, 2001, at R16 [hereinafter Bulkeley].

Official Notice is taken that it is old and well known to relate an item of interest with a previously purchased item by a purchaser and to indicate how the item of interest can be used with the said previously purchased item to enable a user to easily learn about the usefulness of the expressed item of interest and to provide the information the user needs to make a decision regarding the purchase of the item of interest.

Final Act. 19 [hereinafter Official Notice].

The following rejections are before us for review:

1. Claims 5–7, 9, 10, 15, 16, 20–23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Belk and Crawford, Jr.
2. Claims 2 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Bouve.
3. Claims 8 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Bulkeley.
4. Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Official Notice.

ISSUES

Did the Examiner err in rejecting claims 5–7, 9, 10, 15, 16, 20–23 under 35 U.S.C. § 103(a) as being unpatentable over Belk and Crawford, Jr.?

Did the Examiner err in rejecting claims 2 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Bouve?

Did the Examiner err in rejecting claims 8 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Bulkeley?

Did the Examiner err in rejecting claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Official Notice?

ANALYSIS

The rejection of claims 5–7, 9, 10, 15, 16, and 20–23 under 35 U.S.C. § 103(a) as being unpatentable over Belk and Crawford, Jr.

Independent claim 6 calls for “creating a record of in-store behavior having at least one item of expressed interest as expressed by a user” comprising “recording an in-store purchase of said item of expressed interest.”

In that regard, the Examiner found that

Belk discloses recording an in-store purchase of said item of expressed interest (page 1 lines 10-12 and 16-20 and page 2 lines 35-40), “information in the [registry] is automatically updated regardless of whether gift registry selections and purchases are made in a Belk store or through belk.com.” (page 1 lines 11-12), “The registry is integrated with the electronic gift registry system used by Belk stores, so all information in the registry is automatically updated regardless of whether gift registry selections and purchases are made in Belk stores or through belk.com.” (page 2 lines 38-40).

Ans. 4; *see also* Final Act. 4 (relying on page 2 lines 32–34 and page 1 lines 10–12 and 16–20 of Belk).

The Appellants challenge the evidence, arguing that

[a]ccording to Belk, a bride and groom can establish a gift registry in a store, such that guests of the bride and groom are able to purchase the gifts online at Belk.com. The act of creating the gift registry (for inviting guests of the bride and groom to purchase gifts) does not constitute an in-store purchase of an item of expressed interest. A gift registry merely involves the bride and groom identifying items which the bride and groom would like guests of the bride and groom to purchase. Thus, creating the gift registry does not constitute creating a record that comprises recording an in-store purchase of the item of expressed interest.

App. Br. 10 (emphasis omitted).

The evidence weighs in support of the Appellants' position.

Belk discusses a "Belk Gift Registry," and more particularly, an e-commerce website featuring an online Belk Gift Registry via www.belk.com; although the Belk Gift Registry can also be available in-store "where certified professional bridal consultants can provide assistance using the store's online Great Gifts kiosk." Belk 1:8–9. While purchasing an item in the Registry from the kiosk may create a record implying that that item is an item of interest, it does not follow that it also creates a record of *in-store behavior*. We do not see and the Examiner does not adequately explain how purchasing an item in the Registry would necessarily lead to "creating a record of *in-store behavior*" as claimed.

A *prima facie* case of obviousness for the subject matter of claim 6 has not been made out in the first instance by a preponderance of the evidence. Accordingly, the rejection of claim 6 is not sustained. We reach the same conclusion for the rejection of claims 5, 7 and 20 that depend from claim 6.

Like claim 6, independent claims 9 and 15 also call for "recording information relating to *in-store behavior* wherein a purchasing entity identifies an item of expressed interest." The Examiner takes the position as that taken with respect to claim 6. Thus, for the same reasons, a *prima facie* case of obviousness for the subject matter of claims 9 and 15 has not been made out in the first instance by a preponderance of the evidence. Accordingly, the rejection of claims 9 and 15 is not sustained. We reach the same conclusion for the rejection of claims 10, 16, and 21–23 that depend from claims 9 and 15, respectively.

The rejection of claims 2 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Bouve.

The rejection of claims 8 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Bulkeley.

The rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Official Notice.

These rejections of dependent claims are not sustained for the reasons discussed above with respect to the independent claims from which they depend.

NEW GROUND OF REJECTION

Claims 2, 5–12, 15, 16, and 20–23 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

Alice Corp. Party. Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under §101.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

Taking claim 6 as representative of the claims on appeal, the claimed subject matter is directed to customized targeted advertising. Customized targeted advertising is a fundamental economic practice and as such is an abstract idea.

Step two is “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in

practice amounts to significantly more than a patent upon the [ineligible concept] itself.”” *Id.* (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)).

We see nothing in the subject matter claimed that transforms the abstract idea of customized targeted advertising into an inventive concept.

The method of claim 6 sets out three steps.

The first step calls for “creating a record of in-store behavior” about a certain expression of interest in an item. This step is not attached to any device and thus the step, construed reasonably broadly, can be performed mentally. Adding a mental step cannot patentably transform an otherwise abstract idea into an inventive concept. *In re Comiskey*, 554 F.3d 967, 979 (Fed. Cir. 2009) (“mental processes—or processes of human thinking—standing alone are not patentable even if they have practical application”).

The second step calls for creating a targeted message; that is, creating at least a web page comprising two types of information: (a) an advertisement about the item of said expressed interest and (b) “additional advertisement information about another item for which the user has not expressed an interest.” This step seeks to create a web page with information on it, albeit specific types of information. Setting aside that the types of information on the webpage can be characterized as printed matter (*see In re DiStefano*, 808 F.3d 845, 849 (Fed. Cir. 2015) (“limitation is printed matter only if it claims the content of information”)), the creating of the web page, irrespective of the type of information on it, is a known computer-based expedient for communicating information (*cf. buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (stating “[t]hat a

computer receives and sends the information over a network—with no further specification—is not even arguably inventive”). Accordingly, the *creating* of a targeted message as claimed adds nothing of patentable significance to the abstract idea of customized targeted advertising.

The third step calls for sending said targeted message to a user. This step, too, is not attached to any device and thus, reasonably broadly, covers, for example, manually mailing a print-out of the webpage. This is at best a post-solution activity; one that is patentably insignificant. *Cf. Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1244 (Fed. Cir. 2016) (“As noted above, the Board found such recitation of general manual modification to be insignificant post-solution activity.”)

None of these individual steps, viewed “both individually and ‘as an ordered combination,’” transform the nature of the claim into patent-eligible subject matter. *See Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1298). The record creating, targeted message creating, and targeted message sending steps, individually and ‘as an ordered combination’ add little to patentably transform the abstract idea of customized targeted advertising.

Finally, we note that claim 6 implicates the use of a computer in the second step whereby a customized web page is created. But any general-purpose computer available at the time the application was filed would have satisfied this step. The Specification supports that view. *See Spec.* 11:10–20. “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility.” *Alice*, 134 S. Ct. at 2358 (quoting *Mayo*, 132 S. Ct. at 1294).

For the foregoing reasons, we find that claim 6 covers claimed subject matter that is judicially-excepted from patent eligibility under § 101. The other independent claims — method claim 9 and system claim 15 parallel claim 6 — similarly cover claimed subject matter that is judicially-excepted from patent eligibility under § 101. The dependent claims describe various information gathering schemes, including the use of known devices (e.g., “computer,” “handheld device”) to do so, which do little to patentably transform the abstract idea.

Therefore, we enter a new ground of rejection of claims 2, 5–12, 15, 16, and 20–23 under 35 U.S.C. § 101.

For the foregoing reasons, the rejections are reversed but the claims are newly rejected under § 101.

CONCLUSIONS

The rejection of claims 5–7, 9, 10, 15, 16, and 20–23 under 35 U.S.C. § 103(a) as being unpatentable over Belk and Crawford, Jr. is reversed.

The rejection of claims 2 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Bouve is reversed.

The rejection of claims 8 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Bulkeley is reversed.

The rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Belk, Crawford, Jr., and Official Notice is reversed.

Claims 2, 5–12, 15, 16, and 20–23 are newly rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

DECISION

The decision of the Examiner to reject claims 2, 5–12, 15, 16, and 20–23 is reversed.

Claims 2, 5–12, 15, 16, and 20–23 are newly rejected.

NEW GROUND

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED; 37 C.F.R. § 41.50(b)